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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/588,948	08/10/2006	Heiko Urtel	12810-00340-US1	2462
30678 7590 10/26/2009 CONNOLLY BOVE LODGE & HUTZ LLP 1875 EYE STREET, N.W. SUITE 1100 WASHINGTON, DC 20006				
EXAMINER				
NGUYEN, COLETTE B				
ART UNIT		PAPER NUMBER		
1793				
MAIL DATE		DELIVERY MODE		
10/26/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/588,948

Applicant(s)

URTEL ET AL.

Examiner

COLETTE NGUYEN

Art Unit

1793

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 02 October 2009 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 6 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☒ The Notice of Appeal was filed on 02 October 2009. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: _____.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
13. ☐ Other: _____.

/Melvin Curtis Mayes/
Supervisory Patent Examiner, Art Unit 1793

/COLETTE NGUYEN/
Examiner, Art Unit 1793

Continuation of 11, does NOT place the application in condition for allowance because: The arguments filed on 10/02/09 have been carefully considered and the followings :

1. The nonstatutory obviousness-type double patenting of claims 1,2,8,10,12,13,14 over claims 1,5,6,9,12,13,14,15,16,17 of US 7,507,866 stand for the following reasons: The instant claim 1 has the word "comprises" which is considered as an "open" language therefore the claim is not bound to the limitations of the claim but can also include further element. Claim 1 of '866 is limited to rhenium however the claim says rhenium OR ruthenium and at least one further element of atomic number of 22-83 that is not ruthenium. This group of "at least one further element having an atomic number of from 22-83" that "is not ruthenium" either overlaps or encompasses the claimed list of noble metals and at least one further element. The present claim does not exclude rhenium as also being present with any of the claimed noble metals and at least one further element which read on the at least one further element of claim 1 of '866

2. As for the rejections of claims 1-5 and 7-21 under 102 (e), as the certified english translated version was submitted, the rejection is now withdrawn.

3. The rejections of claims 1-5 and 7-21 under 35 USC 103(a) however, stand for the following reasons: As stated clearly in previous action, Kitson teaches catalyzed hydrogenation of carboxylic acids and their anhydrides, saturated or unsaturated, mono, di or polybasic acids and their anhydride derivatives of C2 to C12 to corresponding alcohols and/or esters in the presence of a catalyst of a composition comprising an alloy of at least one noble metal of group VIII and at least one metal capable of alloying with the aforesaid group VIII noble metal (col2, line 10-30), mainly, palladium(Pd), platinum (Pt), rhodium (Rh), ruthenium (Ru), osmium (Os) and iridium (Ir). Metals capable of alloying with palladium including silver, gold, copper, nickel, tin, aluminum, manganese, iron, chromium and platinum. He does not specify optical carboxylic however, he clearly specifies all the derivatives of the carboxylic such as acetic acid, maleic acid, maleic anhydride to gamma butyrolactone (same as claim 7). Anton on the other hand clearly teaches the process for the preparation of optically active alcohols especially optical active carboxylic acids, particularly at low pressure (50-220 bar) and low temperature (70-130C). Anton specifies ruthenium. However, it would be obvious for one of ordinary skill in the art to substitute the ruthenium of Anton with other noble metals such as Pt, Pd, Rh, Ir or Au as disclosed by Kitson as Kitson's process parameters for temperature and pressure ranges are the same from 100-300C and less than 50 bar. Anton does not teach away from using the catalyst, he teaches an equivalent of what Kitson also teaches, therefore it would be obvious for anyone of ordinary skill to combine the teachings and claim a difference.

As for the other arguments, as they are irrelevant to the claims, the examiner chooses not to address them.